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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,151	07/10/2003	Jonathan W. Goodin	2600.2.13	1392

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EXAMINER

CHU, JOHN S Y

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/617,151	Applicant(s) GOODIN ET AL.	
	Examiner John S. Chu	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/18/05, 7/10/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) 5, 6 and 69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/5/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the election received January 18, 2005.

1. Applicant's election without traverse of Group I, claims 1-4 and 7-68 in the reply filed on January 18, 2005 is acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claimed invention as recited in claim 8 is a claim of improper dependent form wherein a dependent claim cannot depend from an ingredient in a previous claim, but rather should depend from the whole claim. Claim 6 refers to a process rather than a lithographic master.

Claim 23 appears to be a typographical error and depends from the lithographic master of claim 9 rather than the method of claim "19"

Correction is necessary.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 7-17, 19 and 48-68 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by HALLMAN et al (6,187,380).

The claimed invention is drawn to the following:

A method for making a negative-working lithographic master for wet offset lithographic printing of an image on a printing medium, comprising the steps of:

(a) coating a layer of positive-working radiation-imageable medium onto a hydrophilic lithographic base;

(b) forming a mask on the surface of said radiation-imageable medium, said mask being in the form of said image and substantially resistant to a developer; and

(c) exposing said layer of radiation-imageable medium to said developer to remove the areas of said radiation-imageable medium that are not covered by said mask.

HALLMAN et al '380 anticipates the claimed invention at Fig. 2b and 3c. Further Examples 5, 6, 28, 29, 32 and 33 anticipate the claimed method for making a negative-working lithographic master for wet offset lithographic printing of an image on printing medium. Example 5 discloses positive plate overcoated on an aluminum base. Subsequently a solid inkjet

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ink was jetted upon the surface of said plate to form an image pattern. That step is followed by an exposure step to UV light. The resultant plate is developed to remove the exposed areas and the unexposed areas accept ink for printing. Here the recited scope of claim 1 is met by the process steps as disclosed in Example 5 wherein the exposure step falls within the open language of “comprising”.

Claims 1-4, 7-17 and 48-68 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by DEUTSCH et al (6,691,618).

The claimed invention has been recited above and is included by reference.

DEUTSCH et al anticipates the claimed invention at column 4, lines 58 – column 5, line 15 and in Examples 1-12, Example 1 column 11, lines 14-20 disclose microdrops comprising water as a solvent, and triethanolamine acetone and a sodium metasilicatepentahydrate as the inkjet composition.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4 and 7-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over HALLMAN et al '380 or DEUTSCH et al '628 in view of MAHOTRA et al or EVANS et al

The claimed invention has been recited above and is included by reference.

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HALLMAN et al and DEUTSCH et al have been recited above and are included by reference for the disclosure relating to the use of inkjet ink as a masking fluid for forming patterned areas on a printing plate precursor.

MAHOTRA et al and EVANS et al are cited to disclose the composition of inkjet ink compositions wherein the compositions include nitrogen containing compounds and ketone compounds in the ink compositions, see column 6, lines 50-55 in MALHOTRA et al and column 4, lines 5-10 in EVANS et al.

It would have been *prima facie* obvious to one of ordinary skill in the art of lithographic printing plate to use know inkjet inks as a pattern forming mask comprising conventional ingredients such as flavones and nitrogen containing compounds in the inkjet ingredients as recite in MALHOTRA et al or EVANS et al with the reasonable expectations of same or similar results with respect to efficiency and economy when imaging by ink.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

NITZAN et al '607 and '270 and NAKAZAWA et al are cited of interest with respect to having ink image printing substrate, however the references lack the coating of the ink over a positive working printing plate.

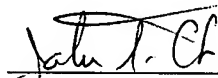
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (571) 272-1329. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

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The fax phone number for the USPTO is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John S. Chu
Primary Examiner, Group 1700

J.Chu
March 18, 2005